

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed September 27, 2006. Claims 1-60 were pending in the Application. In the Office Action, Claims 1-60 were rejected. Claims 1-60 remain pending in the Application. Applicant respectfully requests reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

**DECLARATION FILED PURSUANT TO 37 C.F.R. § 1.131**

In the Office Action, the Examiner asserts that the Declaration filed on June 26, 2006, was considered but deemed ineffective for overcoming a 35 U.S.C. § 102(e) rejection of Claims 1-10, 15-17, 19-23, 25-33, 36-40, 42-43, 46-48, 50-55 and 57-60 of the present Application over U.S. Patent Publication No. 2005/0148299 of Buckley (hereinafter "*Buckley*"). Applicant respectfully traverses. The Examiner appears to assert that Applicant's Declaration is ineffective because the evidence submitted therewith is insufficient to establish a conception of the invention as claimed by Applicant (Office Action, page 2). Specifically, the Examiner states: "However, it is not obvious from the disclosure in Exhibit A that there should be any determining whether the at least one wireless network is on a list of requested wireless networks and switching the wireless device to transmit on mode in response to determining that the at least one wireless network is on a list of requested wireless networks" (Office Action, page 3). Applicant respectfully disagrees.

The invention disclosure form submitted with the Declaration as proof of conception of the invention prior to the purported effective date of *Buckley* clearly indicates determining whether a wireless network is on a list of requested wireless networks. For example, and not by way of limitation, the invention disclosure form recites:

WLAN Quiet mode – Create a WLAN state known as "Quiet Mode". This state will enable the WLAN device to always be in quiet mode during its scanning/not-connected states until it receives a valid wireless network SSID. A "Valid SSID" is defined as an SSID that is currently part of its requested SSID list that has been configured on the system.

(see at least page 5 (section A) of the submitted invention disclosure form) (emphasis added). Further, the invention disclosure form recites that, in some instances, the WLAN device does "[n]ot issue any

probe request until a valid SSID is heard" (see at least page 5 (section A) of the submitted invention disclosure form), that "[a]d-hoc connections would only be made with valid SSID's" (see at least page 5 (section A) of the submitted invention disclosure form), and that "[b]asically the WLAN devices will only communicate and respond to AP's that they have been configured to respond to" (see at least page 5 (section C) of the submitted invention disclosure form). Thus, Applicant respectfully submits that the evidence submitted with the Declaration is sufficient to establish conception of the invention as claimed in Applicant's Application.

Further, the Examiner appears to assert that the evidence submitted with the Declaration is insufficient to establish diligence from a date prior to the purported effective date of *Buckley* to the filing date of the present Application (Office Action, page 3). Applicant respectfully disagrees. However, in further support thereof, Applicant submits herewith declarations of James L. Baudino (the "Baudino Declaration") and L.Joy Griebenow (the "Griebenow Declaration") under 37 C.F.R. § 1.131. James L. Baudino, who is a registered patent attorney, was responsible for preparing and filing the present Application. L.Joy Griebenow, who is a registered patent attorney, is employed as a patent attorney and Senior counsel for Hewlett-Packard, the assignee of the present Application, and was responsible for supervising the preparation and filing of the present Application. The exhibits submitted with the Baudino Declaration and the Griebenow Declaration, along with the Declaration (and supporting exhibits) filed on June 26, 2006, evidence diligent efforts made prior to the purported effective date of *Buckley* continuously up to the filing of the present Application.

As the Examiner will appreciate, the Court of Customs and Patent Appeals, predecessor court to the Federal Circuit, has held that diligence is shown when a patent attorney has a typical practice of reviewing draft patent applications in sequence based on the chronological order in which they are received. *Gould v. Schawlow*, 363 F.2d 908 (CCPA 1966). Moreover, a patent attorney is not required to drop all other work and concentrate on a particular invention. *Rines v. Morgan*, 250 F.2d 365, 369 (CCPA 1957). If the attorney has a reasonable backlog of work that is taken up in chronological order and carried out expeditiously, that is sufficient to establish diligence. *Id.* In view of these legal precedents, Applicant submits that the Griebenow Declaration Exhibit A and Baudino Declaration Exhibits A, B and C in their entirety, along with the corresponding Griebenow Declaration and Baudino Declaration, are sufficient to demonstrate due diligence from a date the prior to January 7, 2004, to the filing of the present application on April 21, 2004.

Based on these facts, Applicant respectfully asserts that a showing has been made that the invention disclosed and claimed in the preset patent Application was conceived prior to January 7, 2004. Additionally, diligent efforts were made from prior to January 7, 2004, through the filing of the present patent Application on April 21, 2004. Thus, Applicant respectfully asserts that prior invention has been demonstrated with respect to the *Buckley* reference. Thus the *Buckley* reference is not prior art to the instant Application. Accordingly, the rejection of Claims of the present Application based on the *Buckley* reference should be withdrawn.

### **SECTION 102 REJECTIONS**

Claims 1-10, 15-17, 19-23, 25-33, 36-40, 42-43, 46-48, 50-55, 57-60 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2005/0148299 issued to *Buckley* (hereinafter "*Buckley*"). Applicant respectfully traverses this rejection.

As indicated above and in the response filed on June 26, 2006, Applicant respectfully submits that Claims 1-10, 15-17, 19-23, 25-33, 36-40, 42-43, 46-48, 50-55, 57-60 of the present Application are patentable over *Buckley*. However, Applicant has elected not to address the patentability of Claims 1-10, 15-17, 19-23, 25-33, 36-40, 42-43, 46-48, 50-55, 57-60 over *Buckley* and instead submit that *Buckley* does not qualify as prior art under Section 102(e) and, therefore, no prima facie rejection has been made. By making this choice, Applicant does not admit the accuracy of the Examiner's remarks or reasoning or acquiesce in any way to the reasoning underlying the rejection.

As indicated above, Applicant conceived of the invention which is the subject of the present Application prior to January 7, 2004, the purported effective date of *Buckley*. In support thereof, Applicant refers to the Declaration under 37 C.F.R. §1.131 of inventor Isaac Lagnado filed June 26, 2006, the Baudino declaration and the Griebenow Declaration, and the respective exhibits thereof, which evidence the conception of the invention prior to the purported effective date of *Buckley* and due diligence from a date prior to the purported effective date of *Buckley* continuously up to the filing of the present Application. Accordingly, Applicant respectfully requests that the rejection of Claims 1-10, 15-17, 19-23, 25-33, 36-40, 42-43, 46-48, 50-55, 57-60 be withdrawn.

### **SECTION 103 REJECTIONS**

Claims 11-14, 18, 24, 34-35, 41, 49 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Buckley* in view of U.S. Patent Publication No. 2004/0003285 issued to Whelan et al. (hereinafter "*Whelan*"). Claims 44-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Buckley* in view of U.S. Patent Publication No. 2004/0153676 issued to Krantz (hereinafter "*Krantz*"). Applicant respectfully traverses these rejections.

#### **Claims 11-14, 18, 24, 34-35, 41, 49 and 56**

Applicant respectfully submits that Claims 11-14, 18, 24, 34-35, 41, 49 and 56 of the present Application are patentable over the *Buckley* and *Whelan* references. However, Applicant elects not to address the patentability of Claims 11-14, 18, 24, 34-35, 41, 49 and 56 over *Buckley* and *Whelan* references, and instead submits that at least primary reference *Buckley* does not qualify as prior art and, therefore, no *prima facie* rejection has been made. By making this choice, Applicant does not admit the accuracy of the Examiner's remarks or reasoning, or acquiesce in any way to the reasoning underlying the rejection.

As discussed above, *Buckley* does not qualify as prior art under 35 U.S.C. § 102(e). At least because *Buckley* does not qualify as prior art against independent Claims 1, 16, 26, 37, 42, 52 and 57, *Buckley* also does not qualify as prior art against dependent Claims 11-14, 18, 24, 34-35, 41, 49 and 56. Further, because *Buckley* does not qualify as prior art, and is effectively removed for that purpose from this §103 rejection, and because *Whelan* is not cited for any of the limitations purportedly taught or suggested by *Buckley*, no *prima facie* rejection has been made. Moreover, Applicant respectfully reserves the right to swear behind *Whelan* in any future office action response should the rejection of Claims 11-14, 18, 24, 34-35, 41, 49 and 56 be maintained. Accordingly, at least for these reasons, Applicant respectfully requests that the rejection of Claims 11-14, 18, 24, 34-35, 41, 49 and 56 be withdrawn.

#### **Claims 44-45**

Applicant respectfully submits that Claims 44-45 of the present Application are patentable over the *Buckley* and *Krantz* references. However, Applicant elects not to address the patentability of Claims 44-45 over *Buckley* and *Krantz* references, and instead submits that at least primary reference *Buckley* does not qualify as prior art and, therefore, no *prima facie* rejection has been made. By making this

choice, Applicant does not admit the accuracy of the Examiner's remarks or reasoning, or acquiesce in anyway to the reasoning underlying the rejection.

As discussed above, *Buckley* does not qualify as prior art under 35 U.S.C. §102(e). At least because *Buckley* does not qualify as prior art against independent Claim 42, *Buckley* also does not qualify as prior art against Claims 44-45 that depend therefrom. Further, because *Buckley* does not qualify as prior art, and is effectively removed for that purpose from this 103 rejection, and because *Krantz* is not cited for any of the limitations purportedly taught or suggested by *Buckley*, no *prima facie* rejection has been made. Moreover, Applicant respectfully reserves the right to swear behind *Krantz* in any future office action response should the rejection of Claims 44-45 be maintained. Accordingly, at least for these reasons, Applicant requests that the rejection of Claims 44-45 be withdrawn.

**CONCLUSION**

Applicant has made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicant has overlooked the need for any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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